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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/646,429

08/22/2003

Robert L. Billmers

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9142

86379

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07/22/2010

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EXAMINER

TRAN LIEN, THUY

ART UNIT

PAPER NUMBER

1781

NOTIFICATION DATE

DELIVERY MODE

07/22/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@nstarch.com

Office Action Summary	Application No. 10/646,429	Applicant(s) BILLMERS ET AL.	
	Examiner Lien T. Tran	Art Unit 1781	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claims 1-8 and 10-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In the amendment filed on 7/12/10, applicant amends claim 1 to recite " a coating consisting essentially of ". This transitional language is not supported by the original disclosure. Page 6 discloses other starches in addition to the starch succinate may be added to change the organoleptic properties of the coating. Inclusion of a flour is cited. Page 7 also discloses other components. Thus, there is no disclosure of a coating consisting essentially of the starch succinate. Example 6, pointed to by applicant, discloses additional starch batter.

Claims 8, 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 is vague and indefinite because it is not clear how it further limits claim 1. Claim 1 recites a " coating consisting essentially of"; yet, claim 8 recites additional component on the coating; thus, it is not clear what is intended.

Claim 23 is vague and indefinite because it is not clear what is intended. The claim does not recite which claim it is depended from. It is not clear if applicant intends for the claim to be an independent claim or dependent claim.

Claims 1-8, 10-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Judkins et al (6033697) in view of Carver et al (US 2003/0039741A1).

Judkins et al disclose a coated frozen par-fried potato product and process of making the product. The process comprises the steps of cutting potato into pieces, blanching the pieces, contacting the pieces with an aqueous solution of one or more hydrocolloids, coating the pieces with an aqueous starch-based batter and frying the coated pieces. Suitable hydrocolloids include starches, modified starches, gum, dextrin etc... and mixtures thereof. The starch batter may contain one or more starches and flours such as wheat flour. The par-fried product is frozen and is prepared for consumption by finish frying. (see col. 2 lines 16-53, col. 3 lines 50-55, col. 4 lines 64-67 and col. 5

Judkins et al do not disclose the starch is substituted with succinate and the characteristics of the starch as in claims 3-7, the percent of fat reduction, reconstitution by oven heating, blanching in water containing the starch as in claim 20.

Carver et al disclose a co-processed composition containing a combination of modified starch and flour. The sources for the starch include corn, potato, wheat, rice, tapioca etc... The base starch for modification includes conversion products including fluidity or thin-boiling, thermal, heat and or acid dextrinization etc..., The modification includes succinate and substituted succinate derivatives or starch. Stabilized starch including starch octenylsuccinate can also be used. The composition demonstrates a combination of desirable appearance, taste, process tolerance, emulsification, cold and hot temperature stability and instant viscosity properties. The composition can be used

Art Unit: 1781

in products including batters, coatings, glazes etc... (see paragraphs 0015,0016.0018, 0030, 0036, 0037)

The amendment of " a coating consisting essentially of" does not define over the prior art. Section 2111.03 of the MPEP states " consisting essentially of" will be construed as equivalent to " comprising" for the purposes of searching for and applying prior art absent a clear indication in the specification or claims of what the basic and novel characteristics actually are". Thus, the language does not define over Carver et al disclosure of a co-processed of starch and flour. Page 6 of the specification discloses additional ingredients added to the coating, including flour. Judkins et al teach to coat the pieces with a starch batter comprising starch and flour; thus, it would have been obvious to one skilled in the to use the composition of Carver et al in the starch batter of Judkins to obtain the superior properties taught by Carver et al. The Judkins et al product is subjected to frying, freezing and finish frying; thus, the cold and hot temperature stability of the Carver et al composition is especially advantageous. Since Carver et al disclose starch substituted with succinate and can also be converted, it is obvious the starch has the characteristics in claims 3-4. Since Carver et al disclose starch substituted with succinate, it is obvious the starch is prepared using the amount of succinic anhydride as claimed. In any event, modification of starch is well known in the art; thus, it would have been within the skill of one in the art to determine the appropriate amount of reagent without undue experimentation. Judkins et al in view of Carver et al disclose the same coating as claimed; thus, it is inherently obvious the same fat reduction is obtained. It would have been obvious to reconstitute by oven

heating when desiring to avoid the additional fat obtained by finish frying. This would have been readily apparent to one skilled in the art. Judkins et al teach contacting with a solution containing one or more hydrocolloids; this is the same as the blanching step of claim 20 because it is contacting the pieces with solution containing water; the claim does not exclude additional blanching step. The hydrocolloids can be modified starches; thus, it would have been obvious to use the Carver et al composition in the hydrocolloid solution to obtain the benefits disclosed by Carver et al. It would have been obvious to use additional starch coating depending on the thickness desired. It would have been obvious to use other starch coating than the one taught by Carver when desiring different flavor and taste.

Claims 1-8, 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keijbets (6635294) in view of Carver et al (6777015).

Keijbets disclose a frozen, fried potato product and a process of making it. The process comprises the steps of forming potato into pieces, blanching the pieces, contacting the pieces with an aqueous solution in which flour batter is added to coat the pieces, pre-frying the pieces and freezing the pieces. The flour batter contains flour, starch, dextrin, leavening agent, thickening agent etc.. (see col. 3 and 4)

Keijbets does not disclose the starch is substituted with succinate and the characteristics of the starch as in claims 3-7, the percent of fat reduction, reconstitution by oven heating, blanching in water containing the starch as in claim 20.

Carver et al disclose a co-processed composition containing a combination of modified starch and flour. The sources for the starch include corn, potato, wheat, rice,

Art Unit: 1781

tapioca etc... The base starch for modification includes conversion products including fluidity or thin-boiling, heat and or acid dextrinization, thermal etc... The modification includes succinate and substituted succinate derivatives or starch. Stabilized starch including starch octenylsuccinate can also be used. The composition demonstrates a combination of desirable appearance, taste, process tolerance, emulsification, cold and hot temperature stability and instant viscosity properties. The composition can be used in products including batters, coatings, glazes etc... (see paragraphs 0015,0016,0018, 0030, 0036, 0037)

The amendment of "a coating consisting essentially of" does not define over the prior art. Section 2111.03 of the MPEP states "consisting essentially of" will be construed as equivalent to "comprising" for the purposes of searching for and applying prior art absent a clear indication in the specification or claims of what the basic and novel characteristics actually are". Thus, the language does not define over Carver et al disclosure of a co-processed of starch and flour. Page 6 of the specification discloses additional ingredients added to the coating, including flour. Keijbets teaches the flour batter comprising starch and flour; thus, it would have been obvious to one skilled in the to use the composition of Carver et al in the flour batter of Jeijbets to obtain the superior properties taught by Carver et al. The Keijbets product is subjected to frying, freezing and finish frying; thus, the cold and hot temperature stability of the Carver et al composition is especially advantageous. Since Carver et al disclose starch substituted with succinate and can also be converted, it is obvious the starch has the characteristics in claims 3-4. Since Carver et al disclose starch substituted with succinate, it is obvious

Art Unit: 1781

the starch is prepared using the amount of succinic anhydride as claimed. In any event, modification of starch is well known in the art; thus, it would have been within the skill of one in the art to determine the appropriate amount of reagent without undue experimentation. Keijbets in view of Carver et al disclose the same coating as claimed; thus, it is inherently obvious the same fat reduction is obtained. It would have been obvious to reconstitute by oven heating when desiring to avoid the additional fat obtained by finish frying. This would have been readily apparent to one skilled in the art. Keijbets teaches contacting with a solution containing the flour batter; this is the same as the blanching step of claim 20 because it is contacting the pieces with solution containing water; the claim does not exclude additional blanching step. It would have been obvious to use additional starch coating depending on the thickness desired. It would have been obvious to use other starch coating than the one taught by Carver when desiring different flavor and taste.

Claims 1, 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shi et al (US2003/0099744).

Shi et al disclose a food composition comprising a food portion and a coating comprising starch succinate that is converted. The starch can be a pregelatinized starch. (see paragraphs 0015, 0017, 0024, 0040)

Shi et al do not disclose the food composition is a fried composition.

It would have been obvious to one skilled in the art to make a fried composition when wanting food having different texture and flavor. Both baking and frying are well

known cooking process in the art and the selection of which depends on the fat content, calorie content, taste, texture, flavor etc.. wanted.

In the response filed 1/22/10, applicant argues that the object of Shi's invention is to provide a glaze that is effective when applied after cooking; thus, there would be no motivation to apply a glaze composition of Shi to a food prior to frying it. The point of applying before frying or after frying is not germane to the issue at hand because the claims rejected are directed to the food product, not a process of making it. Shi teaches to apply the glaze to many different food products including but not limited to pastries, snack, pie, snack products, confectioneries etc... Many of these food products can be fried if a fried texture is wanted. There is no disclosure to conclude that the glaze cannot be applied to food products that have been fried. It would have been obvious to apply to glaze to fried food product to obtain the benefits of the glaze of providing a sheen and surface seal on the fried products. Applicant argues that the process limitation of subsequently fried or par-fried needs to be considered because it results in a different product. The process limitation of "fried" is considered in recognizing that Shi et al do not disclose fried composition. However, the obviousness of forming a fried composition to obtain a fried taste would have been readily apparent to one skilled in the art. Applicant's comment concerning the "reduce fat" is not germane to the claims rejected under Shi because none of the claim has any limitation on fat reduction. A limitation cannot be addressed if it is not in the claims.

Applicant's argument concerning the amended claim 1 as defining over Carver et al is not persuasive as explained in the rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lien T. Tran whose telephone number is 571-272-1408. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

July 19, 2010

/Lien T Tran/

Primary Examiner, Art Unit 1781